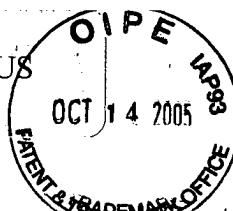


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) S104.12-0051/STL11003	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 14, 2005</u> Signature <u>Diana C. Anderson</u> Typed or printed name <u>Diana C. Anderson</u></p>	Application Number 10/659,616	Filed September 10, 2003	
	First Named Inventor John Frederick Runyon		
	Art Unit 3683	Examiner Robert Siconolfi	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

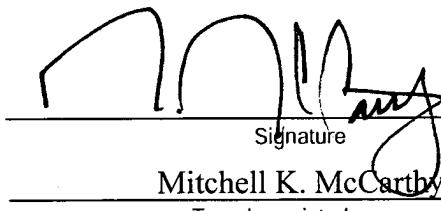
Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 38,794



Mitchell K. McCarthy

Typed or printed name

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Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Dkt. S104.12-0051/STL11003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **John Frederick Runyon**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/659,616** Group Art: **3683**
Filed: **September 10, 2003** Examiner: **Robert Siconolfi**
For: **FLUID ISOLATOR ASSEMBLY AND FLOATING ELASTOMERIC DAMPING ELEMENT**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPLICANT'S REMARKS ACCOMPANYING PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

Please enter the following remarks as Applicant's basis for this Pre-Appeal Brief Request for Review. Generally, this review is necessary and proper because the independent claims stand finally rejected without a completely substantiated basis for the rejections. The Applicant is entitled to a patent unless the invention was previously patented or described. 35 U.S.C. 102 An appealable rejection requires a complete examination: "The examination shall be complete with respect to...the patentability of the invention as claimed. 37 C.F.R. 1.104(a). A complete examination substantiating a Section 102 rejection provides a single reference that identically discloses all the recited features of the rejected claim. The prosecution process, when properly executed, is designed to define the issues on appeal by both the Applicant and Examiner fully setting forth the reasons for and against patentability. When the Examiner maintains anticipatory rejections without fully substantiating them, then the

Applicant is left facing an appeal brief with a distinct disadvantage that is not contemplated by law, due to a case not in condition for appeal for a lack of clearly defined issues.

**IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED
THE ANTICIPATORY FINAL REJECTION OVER HARRISON '388 FOR THE
*CENTRAL MEMBRANE PORTION OF CLAIM 1***

The Applicant has repeatedly argued that Harrison '388 does not identically disclose a *diaphragm with a central membrane portion* that is disposed *substantially parallel to the base*. (see **Applicant's Response of 3/29/05, ppg. 10-11; Applicant's Response of 9/14/2005, ppg. 10-11**)

The Examiner is nonresponsive to Applicant's argument. Instead, the Examiner has deflected Applicant's argument by replying that a non-membrane portion of the diaphragm in Harrison '388 is disposed parallel to the base. (see **Office Action of 7/14/2005, pg. 3**) The Applicant has replied that it is irrelevant that Harrison '388 discloses a feature not claimed.

The Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). In the absence of a rebuttal, this leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner by silence has acquiesced to Applicant's argument; and if so, whether there might be some unexplained reasoning for the rejection. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

**IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED THE
ANTICIPATORY FINAL REJECTION OVER YANAGISAWA '303 FOR THE
DIAPHRAGM AND THE BASE COOPERATIVELY DEFINING A SEALED CHAMBER
OF CLAIM 1**

The Applicant has argued that Yanagisawa '303 does not identically disclose *the diaphragm and the base cooperatively defining a sealed chamber*. (see **Applicant's Response of 9/14/2005, pg. 15**)

Again, the Examiner is nonresponsive to Applicant's argument. Although the Examiner admittedly may have the discretion to finally reject claims on a newly cited reference, that discretion in no way diminishes the Examiner's obligation to make a complete examination with respect to the patentability of the invention as claimed. 37 C.F.R. 1.104(a).

The Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). In the absence of a rebuttal, this leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner by silence has acquiesced to Applicant's argument; and if so, whether there might be some other unexplained reasoning. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED THE ANTICIPATORY FINAL REJECTION OVER HARRISON '388 FOR *DAMP(ING)...HIGH FREQUENCY...VIBRATION(S)* OF CLAIMS 10, 18, AND 21

The Applicant has argued that Harrison '388 does not identically disclose, and the skilled artisan readily recognizes it to be inherently incapable of, damping high frequency vibrations as variously claimed in independent claims 10, 18, and 21. (for claim 10 see **Applicant's Response of 2/29/2005, pg. 11 and Applicant's Response of 9/14/2005, pg.**

11-13; for claim 18 see Applicant's Response of 2/29/2005, pg. 12 and Applicant's Response of 9/14/2005, pg. 13-14; for claim 21 see Applicant's Response of 2/29/2005, pg. 12 and Applicant's Response of 9/14/2005, ppg. 14-15)

The Examiner rebutted Applicant's argument by stating that Harrison '388 discloses different damping elements that will damp different frequencies of vibration; that is, "one will damp a lower frequency and one will damp a higher frequency." (**see Office Action of 7/14/2005, pg. 3**)

Applicant has argued in response that the Examiner's reading of the damping of a comparatively higher of two low frequency vibrations in Harrison '388 onto the claimed damping of high frequency vibrations requires an unreasonably broad construction. This is because one skilled in the art readily recognizes the term "high frequency vibrations" to have ordinary meaning, consistent with its usage in the specification, and associated with the spectral range beyond that of simple mechanical vibrations to vibrations associated with high speed electromechanical vibrations such as motor rotation, highly accelerated components, and the like.

The Examiner apparently does not disagree with Applicant that "high frequency vibration" is a term of art with ordinary meaning. The Examiner stated:

Applicants further argue that oen [sic] skilled in the art would know the meaning of high frequency vibrations. The applicant fails to mention to what art they are referring. Different fields consider different ranges to be high frequency.
(Advisory Action of 10/6/2005, pg. 2, emphasis added)

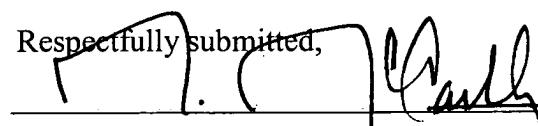
The Examiner thus agrees the claim term "high frequency" ascribes ordinary meaning that is distinguishable from "higher frequency." Given that meaning, however, the Examiner

has not substantiated a basis for Harrison '388 identically disclosing "damping high frequency."

Again, the Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). This leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner, by admitting the ordinary meaning of the claim term but not substantiating the rejection by applying the cited reference according to it, might have some other unexplained reasoning. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

Conclusion

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,
By: 
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